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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,309	01/19/2000	Shosaku Kawai	2406-4	3008

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EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 05/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/487,309

Applicant(s)

KAWAI, SHOSAKU

Examiner

Bunjoo Jaroenchonwanit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5-7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of invention group I (claims 1-13 and 22) in Paper No. 9, filed 05/09/2003 is acknowledged.
2. Claims 14-21 and 23-27 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 9 filed 05/09/2003.
3. This application has been reviewed. Original claims 1-13 and 22 are pending, the objections and rejections cited are as stated below.

Drawings

4. Figure 28 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1-13 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claim 1, the phrase “primary connection information” recited in line 9 renders ambiguity, it is unclear which primary connection information is applicant’s intent. Since the primary connection information, e.g., IP address, conventionally the claimed primary connection information has been used for establishing connection, it is essential that applicant must provide the clear language that would enable examiner to make differentiate the novelty and obviousness of the claim. Further the exemplary languages, “the first communication device sending to the second communication device, primary connection information for connecting to the to first communication device, and identity information for identifying the operator of the first communication device or the first communication device itself, excluding the primary connection information” (claim 1) and “receiving means for receiving primary connection information for making connection to other communication devices and identity information for identifying the operator of the communication device or the communication device excluding the primary connection information; storing and retaining means for storing and retaining the received primary connection information and the received identity information;” (claim 3), such ambiguous languages raise several questions, for example, whether the primary connection information is being sent, how many are they being sent, which one is being excluded and if the primary connection information were excluded from sending, how one could store the information.

The aforementioned languages are exemplary indefinite languages, which are presence in almost every claim. Applicant is suggested that simply using prefix such as, first, second, said, with “primary connection information”, “identity information” would clarify language of the claims. Applicant is also reminded that it is an applicant duty to present the claim languages in

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such a clear and concise manner, ambiguity is definitely would further delay the prosecution.

Appropriate action is required in response to this office action.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-13 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutton et al. (US. 6,513,066) and Sandegren (US 6,512,930).

9. As to claims 1 and 2, Hutton discloses a method and system and device for communication through a network (point-to-point communication thought the Internet between two processing units) comprising:

a host device, a first communication device, and a second communication device (a server, a first and a second processing unit, abstract);

the first and second communication devices being interconnected by obtaining primary connection information from the host device (the first processing unit retrieving IP address from the server, abstract);

if the first communication device prefers a direct call from the second communication device from the next time on (the first processing unit using the IP address for establishing connection to the second processing unit, abstract);

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the first communication device sending to the second communication device, primary connection information for connecting to the to first communication device, and identity information for identifying the operator of the first communication second processing unit device or the first communication device itself, excluding the primary connection information (the first processing unit send IP address, i.e., primary connection information, and email address, i.e. identify information, to the second processing unit, abstract, Col.7, lines 40-57); and

the second communication device storing and retaining the primary connection information and the identity information received from the first communication device; calling up the first communication device according to the primary connection information corresponding to the identity information selected (upon receiving the email, the second processing unit process the mail extract he IP address and use the IP address fro establishing connection to receive, Col. 7, line 66-Col. 8, line 8, inherently, processing and extracting information from email required storing or retaining the information in memory); including displaying name and IP address on the processing devices (Fig. 5 and 6).

Hutton does not explicitly disclose concealing the primary connection information.

However, displaying specific information on a computing or electronic devices was well known and has been optionally utilized in the various art, prior to the invention was made, including in the same filed of endeavor, Sandegren teaches a notification in mobile communication system, receiving status of other mobile device from host computer and display only identity information without prime connection information (Fig. 1a-1c).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate a concept of displaying specific information, e.g., displaying

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name but network address with a system that readily had a capability to do so, as suggested in Hutton, for displaying only identity information, e.g., user or device name, without displaying a prime connection information, e.g., IP or network address, as claimed therein. Because displaying only needed information, e.g., name, identity, in addition of enhancing user privacy by concealing information and limiting to presenting only necessary information, the system's utility would be simplified, allowing the users to browse through the information and making selection, easier.

10. As to claims 3 and 22, Hutton-Sandegren discloses the invention substantially as claimed as discussed in paragraph above, including receiving means for receiving primary connection information for making connection to other communication devices and identity information for identifying the operator of the communication device or the communication device excluding the primary connection information (Hutton discloses, the first processing unit receives an IP address of the second processing unit, including name and email from the server; establishing call to the second processing unit by using the IP address, or sending an IP address, name and email address to the second processing unit for the second processing unit to establish connection to the first processing unit, in order to function as aforementioned, receiving means and its functionalities is required, thereby they are inherent; storing and retaining means, e.g., memory in the processing units and database in the server); display means (Fig. 5 and 6); selecting means (speed dial, directory or send keys, are common selecting means); and connecting means (output device).

11. As claim 4, Hutton-Sandegren discloses the invention substantially as claimed as discussed in paragraphs above, including primary connection information and identity

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information received from other communication devices can be transmitted to another communication device other than the communication device that corresponds to the primary connection information (the first processing unit send IP address and email including name to the second processing unit).

12. Claim 9, Hutton-Sandegren discloses the invention substantially as claimed as discussed in paragraphs above, including, selecting a specific piece of information from the identity information the communication device owns itself, the communication device displays from whom the selected identity information has been obtained (extracting and displaying IP address and Name, Fig. 5-6).

13. As to claims 10-13, Hutton-Sandegren discloses the invention substantially as claimed as discussed in paragraphs above, including, communication device displays the correlation information (displaying name and number); using the system that capable of displaying correlation information to display correlated connection party would have been obvious variation of design choice, since all information between party is exist as the time of connection establish to display or not display is purely desirable choice.

14. Examiner noted that, the language of claims 5-8, if the indefinite issues were addressed and included all of the limitations of the base claims and any intervening claims may be allowable.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

A handwritten signature in black ink, appearing to read 'B. Jaroenchonwanit', with a stylized flourish at the end.

Bunjob Jaroenchonwanit
Examiner
Art Unit 2141

/bj
May 28, 2003